

**AMENDMENT TO THE FIGURE:**

The attached sheet of drawings includes changes to Figure 1A. This sheet replaces the original Figure 1A. Description legends have been added to Figure 1A.

Attachment: Replacement Sheet

### **REMARKS/ARGUMENTS**

The above amendments and these remarks are responsive to the Office Action issued on August 11, 2005. By this response, claims 1, 5, 8, 11, 13, 14, 15, 18, 20-22, 25, 27, 28, 29 and 38 are amended, and claims 31-37 are cancelled without prejudice. Claims 39-41 are newly presented, Paragraph [0020] of the specification is amended to provide updated and correct information for patents/application incorporated by reference. No new matter is added. Claims 1, 2, 4-9, 11-16, 18-23, 25-29 and 38-41 are now active for examination. A Request for Continued Examination is submitted concurrently hereto. Entry of the Amendments is respectfully requested.

#### **Concerning the Drawings**

The Examiner requested that description legends be added to Figure 1A. A replacement Figure 1A is attached.

#### **The Office Action**

The Office Action dated August 11, 2005 rejected claims 1, 2, 4, 6-9, 11-16, 18-23 and 25-38 under 35 U.S.C. §102(b) as being anticipated by Phung et al. (U.S. Publication No. 2002/0007237). Claim 5 was rejected under 35 U.S.C. §102(e) as being anticipated by Papageorge (U.S. Patent No. 6,584,445). The Office Action objected to 1, 2, 4-9, 11-16, 18-23, 25-29 and 38 for lacking appropriate antecedent basis.

**The Telephone Interview**

The Examiner is thanked for the courtesy of granting a telephone interview on September 8, 2005, in which Examiner Mohamed Charioui, Examiner Marc Hoff and Applicants' representative attended. During the interview, differences between claim 1 and Phung, and proposed amendments to claim 1 were discussed. The Examiners agreed that claim 1, after the amendments as presented herein, would overcome the anticipation rejection based on Phung. Applicants' representative agreed to apply changes comparable to those made in claim 1 to independent claims 8, 15, 22 and 38, and to present separate arguments for the rejection of claim 5. It was understood that final determination of the patentability of the claims is subject to any further prior art search that would be performed by the Examiner.

**The Rejection of Claims 30-37 Is Moot**

By this Response, claims 30-37 are cancelled without prejudice. Consequently, the rejection of claims 30-37 is now moot.

**The Anticipation Rejection of Claims 1, 2, 4, 6-9, 11-16, 18-23, 25-29 and 38 Is**

**Overcome**

Claims 1, 2, 4, 6-9, 11-16, 18-23, 25-29 and 38 were rejected as being anticipated by Phung. By this response, claims 1, 8, 11, 14, 15, 18, 20-22, 25, 27, 28 and 38 are amended. Appropriate support for the amendment can be found in, for example, paragraph [0050] of the written description. Claims 5, 11, 14, 18, 20, 21, 25, 27 and 28 are amended to correct clerical errors, but claim scope is not narrowed for any reason related to patentability.

It is respectfully submitted that the anticipation rejection of claims 1, 2, 4, 6-9, 11-16, 18-23, 25-29 and 38 is overcome because Phung cannot support a prima facie case of anticipation.

Claim 1, as amended, describes an expert diagnostic service method that collects data related to fixes corresponding to various symptoms from a plurality of diagnostic system. A validation result of validated effective fixes is accessed. The validation result is generated by performing a validation process to screen out invalid fixes from the collected data. At least one effective fix is assigned to one of the various symptoms based on an accumulated number of the validated effective fixes corresponding to the one of the various symptoms.

On the other hand, Phung describes a global data center 220 that dynamically collects and aggregates repair case information from a plurality of vehicle diagnostic devices through a data network. In paragraph [0017] of Phung, it was described that Phung's system determines the most probably fixes for a symptom based on various factors, like labor intensity. Phung, at most, discusses assigning "preferred" fixes to a symptom. As agreed upon during the telephone interview, Phung does **not** describe a validation process that screens out invalid fixes. Thus, Phung fails to disclose "accessing a validation result of validated fixes corresponding to each of the various symptoms, wherein the validation result is generated by performing a validation process to screen out invalid fixes from the collected data," as described in claim 1.

Furthermore, although Phung's selection process utilizes aggregated repair case information collected from various systems to determine a trend of faults, Phung does **not** specifically describe using "an accumulated number" of each validated fix for the purpose of assigning at least one effective fix to a symptom. Accordingly, Phung fails to disclose "assigning at least one effective fix to one of the various symptoms based on an accumulated number of each of the validated fixes corresponding to the one of the various symptoms," as

described in claim 1. Since Phung does not teach every limitation of claim 1, Phung cannot support a prima facie case of anticipation. The anticipation rejection based on Phung is untenable and should be withdrawn. Favorable reconsideration of claim 1 is respectfully requested.

Claims 2, 4, 6, 7 and 29, directly or indirectly, depend on claim 1 and incorporate every limitation thereof. Therefore, claims 2, 4, 6, 7 and 29 are patentable over Phung for at least the same reasons as for claim 1. Favorable reconsideration of claims 2, 4, 6, 7 and 29 is respectfully requested.

Claim 8, as amended, describes an expert diagnostic method that collects data related to diagnostic results corresponding to various faults from a plurality of diagnostic systems via a data transmission network. A validation result of **validated diagnostic results** is accessed. The validation result is generated by performing **a validation process to screen out invalid diagnostic results from the collected data**. At least one effective diagnostic result is assigned to one of the various symptoms based on **an accumulated number** of the **validated** effective diagnostic results corresponding to the one of the various symptoms. Appropriate support for the amendment can be found in, for instance, paragraph [0050] of the written description.

As discussed earlier related to claim 1, as Phung does not screen out invalid diagnostic results, Phung does not disclose accessing a validation result of **validated diagnostic results**, which is generated by **performing a validation process to screen out invalid diagnostic results from the collected data**, as described in claim 8. Moreover, Phung also fails to specifically teach that **an accumulated number** of the validated diagnostic results is used in assigning at least one effective diagnostic result to a symptom, as described in claim 8.

Since Phung does not disclose every feature of claim 8, Phung cannot support a prima facie case of anticipation. Therefore, claim 8 is patentable over Phung. Favorable reconsideration of claim 8 is respectfully requested.

Claims 9 and 11-14, directly or indirectly, depend on claim 8 and incorporate every limitation thereof. Thus, claims 9 and 11-14 also are patentable over Phung by virtue of their dependencies from claim 8, as well as based on their own merits. Favorable reconsideration of claims 9 and 11-14 is respectfully requested.

Independent claims 15 and 22 include descriptions comparable to those of claim 8. Thus, claims 15 and 22 also are patentable over Phung for at least the same reasons as for claim 8, as well as based on their own merits. Claims 16, 18-21, 23 and 25-25, directly or indirectly, depend on claims 15 and 22, respectively, and incorporate every limitation thereof. Consequently, claims 16, 18-21, 23 and 25-25 also are patentable over Phung at least by virtue of their respective dependencies from claims 15 and 22. Favorable reconsideration of claims 16, 18-21, 23 and 25-25 is respectfully requested.

#### **Claim 5 Is Patentable Over Papageorge**

By this Response, claim 5 is amended to correct clerical errors, but claim scope is not narrowed for any reason related to patentability. In rejecting claim 5, the Office Action contended that Papageorge teaches every limitation of claim 5. Applicants respectfully disagree.

Claim 5 describes an expert patient diagnostic method that collects data related to effective fixes corresponding to various symptoms from a plurality of patient diagnostic systems via a data transmission network. A step is performed to accumulate the number of each effective

fix corresponding to each of the various symptoms. At least one effective fix is assigned to one of the various symptoms based on a result of the accumulating step.

In contrast, Papageorge describes a computerized health evaluation system (CHES) that involves full patient participation in selecting among various treatment options for particular medical conditions and share a decision-making process with a physician. Based on symptoms and preferred treatments submitted by a patient and his/her physician using a data network, the CHES system, in real time, presents treatment options and possible outcomes and costs to the patient and physician.

Although the CHES system collects data from patient/physician and provides treatment options based on the collected data, the effective treatment options are pre-stored in, and sent from, a CHES system. The CHES system does not collect effective fixes from a plurality of patient diagnostic systems. Furthermore, nowhere does Papageorge describe accumulating the **number** of any effective fixes, and assigning an effective fix based on a result of the accumulating step, as described in claim 5.

Since Papageorge fails to disclose every limitation of claim 5, Papageorge cannot support a prima facie case of anticipation. Accordingly, the anticipation rejection of claim 5 based on Papageorge is untenable and should be withdrawn. Favorable reconsideration of claim 5 is respectfully requested.

#### **New Claims 39-41 Are Patentable**

By this Response, claims 39-41 are newly presented. Appropriate support for the new claims can be found in, for instance, paragraphs [0064] of the written description and original claims 12, 19 and 26.

Claim 39 describes an expert patient diagnostic service method that collects data related to diagnostic results corresponding to various symptoms from a plurality of patient diagnostic systems via a data transmission network. A step is performed to accumulate the number of each diagnostic result corresponding to each of the various symptoms. At least one effective diagnostic result is assigned to one of the various symptoms based on a result of the accumulating step. Claims 40 and 41 are system and software claims that include descriptions comparable to those of claim 39.

As discussed above, the CHES system of Papageorge does **not** collect effective diagnostic results from a plurality of patient diagnostic systems. Furthermore, nowhere does Papageorge describe accumulating the **number** of any effective diagnostic results, and assigning an effective fix based on a result of the accumulating step, as described in claims 39-41. It is believed that other documents of record, either alone or in combination, also fail to disclose or suggest every feature of claims 39-41. Favorable consideration of claims 39-41 is respectfully requested.

#### **The Objection to Figure 1A Is Addressed**

The Examiner objected to Figure 1A for lacking descriptive legends for the boxes shown in the figure. By this Response, a replacement Figure 1A is submitted, which includes the descriptive legends as requested by Examiner. It is believed that Figure 1A is now in appropriate form.

#### **The Objection to Claims 1, 2, 4-9, 11-16, 18-23, 25-29 and 38 Is Addressed**

The Office Action objected to 1, 2, 4-9, 11-16, 18-23, 25-29 and 38 for lack of appropriate antecedent basis for “the number.” It is believed that after the current amendments, the claims are in appropriate form.



**CONCLUSION**

For the reasons given above, Applicants believe that this application is in condition for allowance, and request that the Examiner give the application favorable reconsideration and permit it to issue as a patent. If the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representative listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to **Deposit Account 500417** and please credit any excess fees to such deposit account.

Respectfully submitted,

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